

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/862,039 05/22/97 BIRD

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PM82/1020

EXAMINER

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BLUM, T

ART UNIT

PAPER NUMBER

3662

19

DATE MAILED:

10/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	08/862039 Examiner T. BLUM	BIRD Group Art Unit 3662

**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on 8-12-99.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) 1-49 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-49 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

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Upon further consideration:

1. Claim 32 is objected to because of the following informalities: the underlining requirements of 37 CFR 1.121 have not been met. Appropriate correction is required.

M.P.E.P. 714.22 Entry of Amendments, Directions for [R - 1]

>37 CFR 1.121. Manner of making amendments.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.\*

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(e) In reissue applications, both the descriptive portion and the claims are to be amended by either (1) submitting a copy of a portion of the description or an entire claim with all matter to be deleted from the patent being placed between brackets and all matter to be added to the patent being underlined, or (2) indicating the exact word or words to be stricken out or inserted and the precise point where the deletion or insertion is to be made. Any word or words to be inserted must be underlined.

See § 1.173.

2. Claims 1-49 are rejected since these claims recapture claimed subject matter deliberately canceled in application serial Number 07/978,272.

For example:

Claims 28-33 in serial Number 08/862,039 recapture subject matter from canceled claim 31 in serial Number 07/978,272.

See M.P.E.P. 1412.02.

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A reissue will not normally be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent\*> Ball Corp v. United States , 729 F.2d 1429, 221 USPQ 289, 295 (Fed. Cir. 1989);< In re Willingham , 282 F.2d 353, 127 USPQ 211 (CCPA 1960). \*\*>;< In re Richman , 161 USPQ 359, 363, 364 (CCPA 1969); \* In re Wadlinger, \*\*181 USPQ 826 (CCPA 1974). As \*>stated< by the \* >Federal Circuit< in Ball \*\*> : <

The recapture rule bars the patentee from acquiring, through reissue claims that are of the same or broader scope than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the canceled claims. If the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue must be sought within 2 years after the grant of the original patent.

3. Any inquiry concerning this communication should be directed to Theodore Blum at telephone number (703) 305-1833.

Any inquiry concerning reissue procedures in general, should be directed to Mr. Steve Meyers (703) 308-3868 or Mr. Randy Reese (703) 308-2121.

*Theodore M. Blum*  
THEODORE M. BLUM  
PRIMARY EXAMINER